

Serial No. 10/506,480
Examiner Noakes
Group Art Unit 1656

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STATUS OF CLAIMS

Claims 1-6 are pending in the application. Claims 2-6 were withdrawn from consideration pursuant to an election requirement. Thus, Claim 1 drawn to SEQ ID NO: 8, is currently under examination. Applicant has hereby amended Claim 1 so that it is drawn to SEQ ID NO: 11. Applicant states that SEQ ID NO: 8, which is the elected species, is fully encompassed within SEQ ID NO: 11 (which contains three additional amino acids). Thus, Applicant states that the amendment is fully within the original election. Support for the amendment is provided in the original claims and specification, *inter alia*, which provides the sequence relating to SEQ ID NO: 11. Applicant has amended paragraph [0008] to identify appropriately each of the three amino acid sequences cited therein with a SEQ ID NO. designation. Applicant states that the amendments do not present an issue of new matter.

Informality

In the Office Action, the Examiner notes that in paragraph [0008] of the specification, there are three defined amino acid sequences for which no sequence listing number has been assigned.

In response, Applicant hereby amends paragraph [0008] to identify the sequences appropriately by SEQ ID NO. In addition, Applicant states that it will submit a substitute copy of the corrected sequence listing in which the three amino acid sequences shown in paragraph [0008] are included (paper copy and CRF), with the supporting documents for directing its entry in the specification, and a statement that the content of the paper and CRF copies are the same.

Rejection Under 35 U.S.C. §101

Claim 1 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Examiner asserts that the peptide as claimed, which can comprise SEQ ID NO. 8, wherein position three can be Glu, Asp or Gly, has an amino acid sequence duplicative of several found in nature.

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In response, Applicants respectfully traverse the rejection and its accompanying remarks. As amended, Claim 1 is directed to a streptavidin-binding peptide comprising an amino acid sequence according to SEQ ID NO. 11, wherein X at position 3 is selected from the group consisting of glutamic acid, aspartic acid, or glycine. As evident from the specification, SEQ ID NO. 11 is SEQ ID NO. 8 to which three additional amino acids, denoted as XXR, have been attached. Comparing the claimed sequence with those of the prior art cited in Appendix A of the Office Action, it is readily apparent that none of the cited amino acid sequences have "R" in the position corresponding to position 9 of SEQ ID NO. 11. Applicant hereby attaches an annotated Appendix A, which provides a side by side comparison of SEQ ID NO. 11 vis-à-vis the prior art cited by the Examiner. Such comparison demonstrates that the claimed sequence is different from and not duplicative of those which the Examiner indicates are found in nature.

Given such differences between the sequences of nature that the Examiner cites and that of the claimed invention, Applicant respectfully submits that the rejection has been obviated and respectfully requests that the Examiner reconsider and withdraw the rejection under § 101.

Rejection Under 35 U.S.C. §102(c) - Goldman et al., Rubenfield et al., Yoshida et al., or Yoshioka et al.

Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Goldman et al. (U.S. Pat. No. 6,833,447), Rubenfield et al. (U.S. Pat. No. 6,551,795), Yoshida et al. (J. Bacteriol. 181:6081-6091, 1999), or Yoshioka et al. (DNA Res. 4:363-369, 1997).

In response, Applicants respectfully traverse the rejections and their accompanying remarks. Applicant states that the rejection is rendered moot by the fact that SEQ ID NO. 11 as claimed, is not found in nature. This is evidenced by the fact that a direct comparison of the claimed sequence with sequences disclosed in the documents cited by the Examiner, shows that the claimed sequence is different from those sequences found in nature.

For a reference to anticipate a claim it must disclose *each and every element* of the claim. See MPEP 2131 and cases cited therein, *especially Richardson v. Suzuki Motor Co.*,

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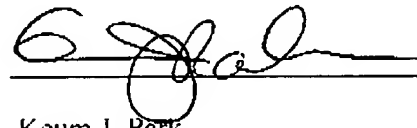
868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) and *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (Fed. Cir. 1978)(emphasis added).

Thus, since the cited references fail to disclose all of the features of the claimed invention, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under § 102(b) as anticipated by Goldman et al., Rubenfield et al., Yoshida et al., or Yoshioka et al.

CONCLUSION

In light of the above, Applicant respectfully submits that Claim 1 is in condition for allowance, early notification of which is earnestly solicited. Should the Examiner be of the view that an interview would expedite the application at large, request is made that the Examiner telephone the undersigned attorney at (908) 518-7700, ext. 7 in order to resolve any outstanding issues.

Respectfully submitted,



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